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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,054	10/19/2001	Thomas G. Krajewski	D-2778/WOD	6676

7590 01/28/2004

William O'Driscoll - 12-1
The Trane Company
3600 Pammel Creek Road
La Crosse, WI 54601

EXAMINER

KOVALICK, VINCENT E

ART UNIT	PAPER NUMBER
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2673

DATE MAILED: 01/28/2004

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/004,054

Applicant(s)

KRAJEWSKI ET AL.

Examiner

Vincent E Kovalick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-137 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-137 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is in response to Applicant's Patent Application, Serial No. 10/004,054, with a File Date of October 10, 2001.

Restriction

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claims 1-16 and 55-69, drawn to calibrating a touch-screen display, classified in class 345, subclass 178.

Group II. Claims 17-39, 70-90, 102-107 and 108-112, drawn to generating and validating pixel coordinate of a touch-screen display, classified in class 178, subclass 18.01.

Group III. Claims 40-54, 91-101, 113-116, 122, 125-126 and 132-137, drawn to detecting a "no touch" state of a touch-screen display, classified in class 345, subclass 173.

Group IV. Claims 117-121, 123-124 and 127-137 drawn to processing analog to digital converter signals to a touch-screen display, classified in class 341, subclass 155.

3. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant

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case, the combination as claimed does not require the particulars of the subcombination as claimed because each of the subcombinations are related to different functions associated with touch-screen operations, e.g. calibrating the touch-screen display versus generating and validation pixel coordinate estimates. The subcombination has separate utility such as calibrating display devices of different sizes and different technologies, or validating pixel coordinates of display devices or technologies different from touch-screen.

Inventions I and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because each of the subcombinations are related to different functions associated with touch-screen operations, e.g. calibrating the touch-screen display versus detection of a “no touch” state. The subcombination has separate utility such as calibrating display devices of different sizes and different technologies, where the “no touch” feature could be applied to other display input devices e.g. keyboards.

Inventions I and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because each of the subcombinations are related to different functions associated with

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touch-screen operations, e.g. calibrating the touch-screen display versus reading analog to digital converter signals to a touch-screen . The subcombination has separate utility such as calibrating display devices of different sizes and different technologies, or processing analog to digital converted signals to a video display system.

Inventions II and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because each of the subcombinations are related to different functions associated with touch-screen operations, e.g. generating and validation pixel coordinate estimates versus detection of a “no touch” state. The subcombination has separate utility such as validating pixel coordinates of display devices of technologies different from touch-screen, or the “no touch” feature could be applied to other display input devices, e.g. keyboards.

Inventions II and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because each of the subcombinations are related to different functions associated with touch-screen operations, e.g. generating and validation pixel coordinate versus processing analog to digital converter signals to a touch-screen . The subcombination has separate utility

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such as validating pixel coordinates of display devices of technologies different from touch-screen, or processing analog to digital converted signals to a video display system.

Inventions III and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because each of the subcombinations are related to different functions associated with touch-screen operations, e.g. detection of a “no touch” state versus processing analog to digital converter signals to a touch-screen. The subcombination has separate utility such as the “no touch” feature could be applied to other display input devices, e.g. keyboards, and processing analog to digital converted signals to a video display system.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and the search required for Groups I-IV is not required for Groups, I-IV restriction for examination purposes as indicated is proper.

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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Responses

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vincent E Kovalick whose telephone number is 703 306-3020.


The examiner can normally be reached on Monday-Thursday 7:30- 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached on 703 305-4938. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 306-0377.



Vincent E. Kovalick
January 16, 2004



BIPIN SHALWALA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2000